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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,340

06/17/2005

Fumitsugu Fukuyo

46884-5319

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55694 7590 09/08/2008  
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EXAMINER

LE, DUNG ANH

ART UNIT

PAPER NUMBER

2818

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/507,340	<b>Applicant(s)</b> FUKUYO ET AL.	
	<b>Examiner</b> DUNG A. LE	<b>Art Unit</b> 2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 and 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 18, 26 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:6/12/2008,03/31/2008,02/19/2008,02/12/2008,01/08/2008

09/05/2007,08/23/2007,08/07/2007,07/24/2007,07/18/2007,06/14/2007,06/06/2007,04/26/2007.

11/09/2006,06/20/2006,04/20/2006,04/04/2006,02/28/2006 and 08/30/2005

## DETAILED ACTION

### Priority

Acknowledge is made of applicants' claim for foreign priority base on an application 2002-67372 filed in Japan on 03/12/2002.

It is noted that Applicants have filled a certified copy of said application as required by U.S.C 119, which papers have been placed of record in the file.

### Oath/Declaration

The oath/declaration filed on 06/17/2005 is acceptable.

### Election/Restriction

Applicant's election with traverse of **Species II, Method of cutting an object to be processed comprising a modified region is a molten process region** is acknowledged.

Because Applicant did not distinctly and specifically point out the supposed error in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicants have the right to file a divisional application covering the subject matter of the non-elected claims **Species I and III**.

The traversal is on the ground(s) that see the election paper. This is not found persuasive because the fields of search for the plural of species claims are NOT coextensive and the determinations of patentability of the plural of species claims are different, that is the plural of species limitations are given weight differently in determining the patentability of the claimed inventions. For example, this application contains claims directed to the following patentably distinct species of the claimed invention:

**a) Species I**, Method of cutting an object to be processed comprising a modified region is a Crack region.

**b) Species II**, Method of cutting an object to be processed comprising a modified region is a Molten process region.

**c) Species III**, Method of cutting an object to be processed comprising a modified region is a Reflective Index change region.

Therefore, the strategies for doing text searching of the plural of species are different. Thus, separate searches are required.

The requirement is still deemed proper and is therefore made FINAL.

### **Specification**

The specification has been checked to the extent necessary to determine the presence of all possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **Claim Rejections**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 14 is rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claim 3 of US. Patent 6,992,026**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention was made to cause the molten processed region to form a starting point region for cutting, deviated from a center position of the object in a thickness direction thereof toward one end face of the object, along a line along which the object should be cut in the object; and a pressing step of pressing the object from the other end face side of the object by introducing a starting point, from which cutting of the object starts, constituted by the modified region in a region separated from a surface of said object a laser light entrance face side toward inside by a predetermined distance, along a line along which

Art Unit: 2818

the object is intended to be cut in order to define inventive method of cutting an object to be processed.

**Claim 18 is rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claim 22 of US. Patent 6,992,026**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention was made to cause the molten processed region to form a starting point region for cutting, deviated from a center position of the object in a thickness direction thereof toward one end face of the object, along a line along with the object should be cut in the object; and a pressing step of pressing the object from the other end face side of the object by introducing a molten processed region within the object, to form a starting point, from which cutting of the object starts, constituted by the modified region, in a region separated from a surface of said object a laser light entrance face side toward inside by a predetermined distance, along a line along which the object is intended to be cut in order to define inventive method of cutting an object to be processed.

**Claim 26 is rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claim 3 of US. Patent 6,992,026**. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention was made to

Art Unit: 2818

form a modified region including a molten processed region within the object, with the modified region forming a starting point region serving as a starting point for cutting, deviated from a center position of the object in a thickness direction thereof toward one end face of the object, the object along a line along which the object is to be cut; and a pressing step of pressing the object from the other end face side of the object, with such pressing thereby resulting in cutting the object along the line along which the object is to be cut in order to provide at least one manufactured semiconductor device by introducing a starting point, from which cutting of the object starts, constituted by the modified region in a region separated from a surface of said object a laser light entrance face side toward inside by a predetermined distance, along a line along which the object is intended to be cut in order to define inventive method of cutting an object to be processed.

**Claim 29 is rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claim 22 of US. Patent 6,992,026**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention was made to form a molten processed region within the object, with the molten processed region forming a starting point region serving as a starting point for cutting, deviated from a center position of the object in a thickness direction thereof toward one end face of the object, the object along a line along which the object is to be cut; and a pressing step of pressing the object from the other end face side of the object, with such pressing thereby resulting in cutting the object along the line along which the



object is to be cut in order to provide at least one manufactured semiconductor device by introducing a molten processed region within the object, to form a starting point, from which cutting of the object starts, constituted by the modified region, in a region separated from a surface of said object a laser light entrance face side toward inside by a predetermined distance, along a line along which the object is intended to be cut in order to define inventive method of cutting an object to be processed.

When responding to the office action, Applicants' are advice to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung A. Le whose telephone number is (571) 272-1784. The examiner can normally be reached on Monday-Tuesday and Thursday 6:00am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Loke can be reached on (571) 272-1657. The central fax phone numbers for the organization where this application or proceeding is assigned are (571)272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

Art Unit: 2818

more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DUNG A LE/  
Primary Examiner, Art Unit 2818